

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-19, 22-30, 33-46, 49-51, and 54 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter; rejected claims 1-7, 9-38, 40-49, and 51-54 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,107,271 to Aoki et al. ("Aoki") in view of U.S. Patent No. 6,011,895 to Abecassis ("Abecassis"); and rejected claims 8, 39, and 50 under 35 U.S.C. § 103(a) as being unpatentable over Aoki in view of Abecassis, and further in view of U.S. Patent No. 6,199,076 to Logan et al. ("Logan").

Applicant amends claims 1-6, 9-15, 18-21, 23-29, 31, 32, 34-38, 40-44, 46-48, and 50-53 and cancels claims 7, 8, 16, 17, 22, 30, 33, 39, 45, and 49-54. Claims 1-6, 9-15, 18-21, 23-29, 31, 32, 34-38, 40-44, and 46-48 are pending in the application.

Applicant respectfully traverses the rejection of claims 1-19, 22-30, 33-46, 49-51, and 54 under 35 U.S.C. § 101.

The Examiner alleges that claims 1-19, 23-30, 34-46, 50, and 51 are non-statutory because they "disclose a system or apparatus but do not describe any hardware." Office Action at 2. Applicant respectfully disagrees.

Claims 1-6, 9-15, 18, 19, 23-29, 34-38, 40-44, 46, 50, and 51 employ means plus function language. When means plus function language is used in the claims, Office personnel must construe the claims in view of 35 U.S.C. § 112, sixth paragraph, which states that "[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of structure, material, or acts*

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

in support thereof, and such claim shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof" (emphasis added).

See In re Donaldson, 16 F.3d 1189 (Fed. Cir. 1994).

Applicant's specification describes in detail the hardware "to which the present invention is applied" at, for example, paragraphs 121-126, 152-168, and 180-182 of the specification (Pre-grant Publication), with respect to Figs. 1, 3, 4, and 6. The means plus function elements of these claims therefore invoke the appropriate hardware described in Applicant's specification. Claim 1-6, 9-15, 18, 19, 23-29, 34-38, 40-44, 46, 50, and 51 thus do not recite software alone, and the rejection of those claims under 35 U. S. C. § 101 is improper.

In addition, claims 7, 8, 16, 17, 22, 30, 33, 39, 45, and 49-54 have been canceled, rendering the rejection of these claims under 35 U. S. C. § 101 moot. Applicant therefore respectfully requests the withdrawal of the rejection of claims 1-19, 22-30, 33-46, 49-51, and 54 under 35 U.S.C. § 101.

Applicant respectfully traverses the rejection of claims 1-7, 9-38, 40-49, and 51-54 under 35 U.S.C. § 103(a) as being unpatentable over Aoki in view of Abecassis. Aoki and Abecassis, even if combined as suggested by the Examiner, do not disclose or suggest each and every element of claims 1-7, 9-38, 40-49, and 51-54.

Independent claim 1, as amended, recites an information search system comprising, among other features,

means for analyzing an electronic mail message associated with a user to extract an interest word . . .

means for sending a request to the information search apparatus to search program information based on the extracted interest word . . . [and]

means for sending program information identified by the search to the information processing apparatus.

Aoki and Abecassis fail to disclose or suggest at least the claimed means for analyzing an electronic mail message, means for sending a request, and means for sending program information.

Aoki discloses "an agent interface device [that] provides information suited for user preferences on the basis of a usage history." Aoki, abstract. In Aoki, when a TV program is viewed, an information providing engine stores the TV program data in a user preference database. Aoki, col. 6, ll. 35-40. The engine also recommends programs to the user by "[referring] to the usage history contained in the user preference database DB108 to extract a keyword common to the programs that the user preferred . . ." Aoki, col. 6, ll. 47-50. The engine then "refers to the EPG (Electronic Program Guide) . . . and searches therein a program having the common keyword previously extracted from the database DB108 or a similarly meaning keyword." Aoki, col. 6, ll. 52-55.

Aoki, however, fails to disclose or suggest "*analyzing an electronic mail message . . . to extract an interest word . . . sending a request . . . to search program information based on the extracted interest word . . . [and] sending program information identified by the search to the information processing apparatus*" (emphasis added), as recited by independent claim 1.

Abecassis fails to remedy the deficiencies of Aoki. Abecassis discloses "an automated system and method that furnishes viewers with individualized automated editing and retrieval capabilities over the contents and length of a variable content video program." Abecassis, abstract; and col. 1, ll. 8-11. In Abecassis, "each segment [of a program] is analyzed as to subject matter and assigned the necessary keyword . . . [which] provides the capability for inhibiting the viewing of undesirable subject matter, or assisting in the retrieval of desirable subject matter." Abecassis, col. 7, ll. 8-11 and 16-18. Programs are played on a segment-by-segment basis in accordance with a user's preferences. Abecassis, col. 9, ll. 53-64; col. 13, ll. 13-21; and Figs. 4 and 6.

Abecassis, however, also fails to disclose or suggest "analyzing an electronic mail message . . . to extract an interest word . . . sending a request . . . to search program information based on the extracted interest word . . . [and] sending program information identified by the search to the information processing apparatus," as recited by independent claim 1.

Independent claims 11, 21, 23, 31, 32, 34, 41, 47, and 48 while of different scope than claim 1, patentably distinguish from Aoki and Abecassis for similar reasons as claim 1. Claims 2-6, 9-10, 12-15, 18, 19, 24-29, 35-38, 40, 42-44, and 46 patentably distinguish from Aoki and Abecassis at least due to their dependence from one of claims 1, 11, 23, 34, and 41. Claims 7, 16, 17, 22, 30, 33, 39, 45, and 49-54 have been canceled. Applicant therefore respectfully requests the withdrawal of the rejection of claims 1-7, 9-38, 40-49, and 51-54 under 35 U.S.C. § 103(a) as being unpatentable Aoki in view of Abecassis.

Applicant respectfully traverses the rejection of claims 8, 39, and 50 under 35 U.S.C. § 103(a) as being unpatentable over Aoki in view of Abecassis, and further in Logan. Claims 8 and 39 have been canceled.

Independent claim 50, while of different scope than independent claim 1, distinguishes from Aoki and Abecassis for at least the same reasons as claim 1. Logan, however, fails to remedy the deficiencies of Aoki and Abecassis discussed above. Logan discloses "a system for dynamically and interactively selecting and playing particular programs from a program library." Logan, col. 1, ll. 7-9. Logan, however, fails to disclose or suggest "analyzing electronic mail associated with a user . . . to extract an interest word . . . sending a request . . . to search program information based on the extracted interest word . . . [and] sending program information identified by the search to the information processing apparatus," as recited by independent claim 1.

For these reasons, Applicant respectfully requests the withdrawal of the rejection of claims 8, 39, and 50 under 35 U.S.C. § 103(a) as being unpatentable over Aoki in view of Abecassis, and further in Logan.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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